

REMARKS

This responds to the Final Office Action mailed on January 6, 2009. Applicants have amended claim 19. Claims 1-12, 16-18, and 25 remain canceled and no claims are added. Consequently, claims 13-15, 19-24, and 26-29 remain pending in this application.

Rejection of the Claims under 35 U.S.C. §101

On page 2, paragraph 2 of the Office Action, the Examiner rejected claims 27-29 as being directed to non-statutory subject matter. Specifically, the Examiner stated that,

Claims 27-29 recite a method comprising steps that may be performed mentally and/or manually by a human being. Thus the method neither explicitly recites another statutory class of invention . . . nor inherently requires the use of a particular machine or apparatus. (Emphasis in original.)

In response, Applicants respectfully remind the Examiner that the proper test for patent eligibility under 35 U.S.C. §101 is the machine-or-transformation test. The United States Court of Appeals for the Federal Circuit (CAFC) recently held that the machine-or-transformation test is the sole criterion for patent eligibility under § 101. The CAFC additionally stated that,

The Supreme Court, however, has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. ***A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.*** (*In re Bilski*, 545 F.3d 943, 954). Emphasis added.)

With regard to the second prong of the *Bilski* test, the *Bilski* court clarified how the transformation prong can be applied. The CAFC cited to the *Abele* court¹ approvingly when it stated,

¹ *In re Abele*, 684 F.2d 902 (CCPA 1982).

We further note for clarity that *the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented. We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-transformation test, namely the prevention of pre-emption of fundamental principles. (Bilski at 963. Emphasis added.)*

Applicants' claim 27 recites, *inter alia*,

[D]etermining *a number of images to display* in the markup language document . . .

obtaining a set of random numbers, the set of random numbers containing a plurality of random numbers, *a number of the plurality of random numbers being equal to the determined number of images*;

retrieving images from a group of images using the set of random numbers, each retrieved image being associated with an item represented in that retrieved image; and

placing the retrieved images in the markup language document.
(Emphasis added.)

Applicants have used the term “image” in the as-filed application to indicate, for example, “[e]ach thumbnail image record contains data associated with *an auction item represented by the image.*” (*Specification* at 7, line 21 to 8, line 1. Emphasis added.) Thus, the “image,” found in each element of claim 27, *is an image of an underlying physical object that the data represented, thus meeting the transformation test* as defined by *Abele*. Consequently, the claim meets the second prong of the *Bilski* machine-or-transformation test. Applicants therefore respectfully request the Examiner remove the rejection under 35 U.S.C. §101 with reference to claim 27 and claims 28 and 29 that depend therefrom.

Rejection of the Claims under 35 U.S.C. §103(a)

On page 3, paragraph 3 of the Office Action, the Examiner rejected claims 13-15, 19-24, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,007,076 to

Hess et al. (*Hess*) in view of “JavaScript Handout 2” (*JavaScript*). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)). Emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants’ claims.

Independent Claims 13, 19, 26, and 27

Applicants’ amended claim 13 recites, *inter alia*,

[D]etermining a number of images to display in the markup language document;

obtaining a set of random numbers, the set of random numbers containing a plurality of random numbers, ***a number of the plurality of random numbers being equal to the determined number of images***; [and]

retrieving images from a group of images using the set of random numbers, ***each retrieved image being associated with an item represented in that retrieved image***. (Emphasis added.)

Applicants’ other independent claims, 19, 26, and 27, each contain similar limitations.

The Examiner relies on *Hess*² to teach Applicants’ claimed element of “determining a number of images to display.” However, in contrast to Applicants’ claim, *Hess* merely discusses a means to efficiently store a large number of thumbnail images.

² See Office Action at 4.

Importantly, as one feature of the present embodiment, ***thumbnail images are not stored as individual files; rather, they are stored in an efficient database format*** that will be described further below. . . . The practicality of storing and maintaining thousands upon thousands of individual compressed thumbnail image files is questionable at best. (*Hess* at col. 5, lines 55-63, emphasis added.)

Thus, *Hess* discusses efficiently storing a large number of thumbnail images by not storing the thumbnails as individual files. *Hess* is silent on “determining a number of images to display.” Instead of determining a number of images to display, *Hess* focuses on how to harvest ***all*** images.

[T]humb building machine 450 includes a harvesting process 455 and a database 460. As will be described further below, ***the harvesting process 455 periodically harvests images that sellers have associated with items in the listing database 420.*** (*Id.* at col. 5, lines 37-41, emphasis added.)

Consequently, since *Hess* merely harvests all images, *Hess* neither teaches nor suggests Applicants’ claimed element of “determining a number of images to display in the markup language document.”

The Examiner relies next on *JavaScript*³ to teach Applicants’ claimed element of “a number of the plurality of random numbers being equal to the determined number of images.” However, contrary to the Examiner’s assertion, *JavaScript* discusses nothing more than preparing code to generate random numbers with a constraint of not having the same random number being generated twice in a row.

That way the randomizer might hit the same value repeatedly (for instance, 5, 7, 5, 3, 5, 10, 5) ***but never twice in succession.*** The simplest way to make this adjustment involves placing your randomizer within a while loop:

```
var randyOld = 0;
var randy = 0;
while(randy == randyOld)
{
  randy = Math.round {Math.random ( ) * 10};
}
```

³ See *Office Action* at 5.

```
    }  
    randyOld = randy;
```

The while statement tells the browser to execute whatever is within the curly braces {} so long as the test condition is true. (JavaScript at 2, emphasis added.)

Further, the Examiner states that *JavaScript*'s disclosure of "[g]enerating random numbers . . . pick any number between 1 and x"⁴ teaches the plurality of random numbers being equal to the determined number of images, as recited in the claims. Although not stated expressly, the Examiner seems to imply that "x" corresponds with the determined number of images. However, the variable "x" as defined in *JavaScript* is nothing more than a maximum value returned by the random number generator.

[T]o generate a number at random:
Math.ceil(Math.random()*x)
This statement works fine if all you want to do is pick any number between 1 and x, inclusive. (*JavaScript* at 2, emphasis added.)

Therefore, even if a combination of the references of *Hess* and *JavaScript* taught determining a number of images, which they do not, the variable "x" discussed in *JavaScript* is nothing more than a maximum value for the random number generator and not the number of images as asserted.

Therefore, no combination of *Hess* and *JavaScript*, singly or in combination, teach Applicants' claim element of "a number of the plurality of random numbers being equal to the determined number of images."

The Examiner finally relies exclusively⁵ on *JavaScript* to teach Applicants' claimed element of "retrieving images from a group of images using the set of random numbers, each retrieved image being associated with an item represented in that retrieved image." However,

⁴ *Ibid.*

⁵ "Hess, however, does not explicitly teach . . . 'retrieving images from a group of images using the set of random numbers, each retrieved image being associated with an item represented in that retrieved image.'" (*Ibid.*)

here again *JavaScript* is silent on each retrieved image ***being associated with an item represented in that retrieved image***. *JavaScript* discusses pre-loading images, nothing more.

In fact, no teaching or even hint exists within *JavaScript* of each retrieved image being associated with an item. ***Asserting that the cited reference teaches the Applicants' claimed elements is merely conclusory with no support found in JavaScript.*** “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007)). Although the Examiner cites to portions of the cited reference, there is no rational argument providing a legal nexus between the cited portions and Applicants’ claims.

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Hess* singly or in combination with *JavaScript*, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 13, 19, 26, and 27.

Dependent Claims 14-15, 20-24, and 28-29

Further, since claims 14-15, 20-24, and 28-29 depend, either directly or indirectly from claims 13, 19, and 27, respectively, they too are allowable for at least the same reasons. Further, each of these dependent claims may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 6, 2009.

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